

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT R. HOLCOMB

Appeal No. 2001-0955
Application No. 08/815,971

ON BRIEF

Before GARRIS, LIEBERMAN and JEFFREY T. SMITH, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 28-39 and 41-54 and from the refusal of the examiner to allow claim 40 as amended subsequent to the final rejection.¹ These are all of the claims remaining in the application.

The subject matter on appeal relates to a composition for treating food to alter a

¹ The claim 40 amendment filed January 4, 2000 has not been clerically entered notwithstanding the entry authorization given by the examiner in the advisory action mailed February 2, 2000. Upon return of the application file to the jurisdiction of the Examining Corps, this clerical oversight should be rectified.

property (i.e., flavor) of the food comprising an aqueous suspension of charged silica particles and to a method of modifying the properties of a food with such a composition.

This appealed subject matter is adequately illustrated by independent claim 28 which reads as follows:

28. A composition for treating food to alter a property of the food comprising an aqueous suspension of charged silica particles wherein said aqueous suspension of charged silica particles is generated by slowly lowering the pH of an initial alkaline silica solution while the solution is continuously circulated through a magnetic field to produce charged, relatively stable, colloidal silica particles of size between about 10 and 100 angstroms.

No references have been relied upon by the examiner in the sole rejection before us on this appeal.

All of the claims on appeal are rejected under 35 U.S.C. § 101 “because the invention as disclosed is inoperative and therefore lacks patentable utility.” (answer page 3). According to the examiner “[t]he [appellant’s] assertion of improving the properties mainly enhancing the flavor of the food treated with the charged silica is not credible” (answer page 3). In this regard, the examiner states “it is not known that silica is a flavorant by itself” and therefore concludes that “[t]he asserted utility is not

credible in view of what is known in the art (see the decision set forth in Fregeau v.

Mossinghoff, 227 USPQ 848)” (answer page 4).

OPINION

For the reasons which follow, this rejection cannot be sustained.

On the record of this appeal, the examiner has proffered no specific evidence in support of the “incredible utility” position upon which the § 101 rejection is based.² Instead, this “incredible utility” position seems to have developed as a result of the examiner’s failure to find prior art which discloses using silica per se as a food flavorant. Despite the obvious weakness of such a foundation for the examiner’s § 101 rejection, the appellant has submitted substantial evidence in support of his position that the here claimed charged silica particles possess a food-flavorant utility.

In deference to the examiner’s determination that this evidence is unpersuasive, we acknowledge that a considerable amount of the evidence has not been well developed or well presented in relation to clearly supporting a conclusion that food combined with the here claimed charged silica particles as the only flavorant exhibits enhanced flavor properties compared with the same food without such charged silica particles. Nevertheless, a number of the comparative tests proffered by the appellant provide a least some probative support for this conclusion.

For example, Exhibit D of the Holcomb affidavit dated January 8, 1997 shows

² However, we note that Hawley’s Condensed Chemical Dictionary (11th edition) defines silica as “odorless and tasteless” and therefore provides at least some specific evidentiary support for the examiner’s position.

that dog food sprayed with a solution of Escalade (i.e., the colloidal silica of appellant's invention) was significantly preferred over the control dog food.³ Similarly, the hamburger bun test disclosed at item 11 of the affidavit shows a preference for buns which contain colloidal silica particles of the invention relative to buns which do not. As a further example of evidence supporting the above noted conclusion, item 6 of the Holcomb declaration dated December 28, 1999 makes it clear that the food enhancements shown in specification Examples I-XIII relate to foods which contain colloidal silica of the invention compared to foods which are identical but for the presence of this colloidal silica.

The procedural methodology and the allocation of burdens in assessing claim patentability are well settled. The examiner bears the initial burden of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. After evidence or argument are submitted by the applicant, patentability is determined on the totality of the record by a preponderance of evidence with due consideration to persuasiveness of argument. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In the case before us, it could be argued that the examiner has failed to carry the initial PTO burden of establishing a prima facie case that the appealed claims are

³ The examiner's criticisms of this exhibit bridging pages 9 and 10 of the the answer (i.e., questioning the difference between flavored water with Escalade and adult plus) quite plainly relate to the data of the Exhibit E rather than Exhibit D.

unpatentable under 35 U.S.C. § 101, thus leading to a determination that the § 101 rejection before us is improper. However, even assuming that the examiner has established a prima facie case, the rejection still would be improper. This is because the appellant's evidence of utility and thus patentability for the here claimed invention, though perhaps of limited probative value in some instances, outweigh by far any evidence of record supporting the examiner's contrary position. As a consequence, the totality of the record before us, on balance, unquestionably weighs most heavily in favor of an ultimate determination that the appealed claims are patentable under 35 U.S.C. § 101. Id.

Under these circumstances, the examiner's § 101 rejection of claims 28-54 cannot be sustained.

OTHER ISSUES

Upon return of this application to the jurisdiction of the Examining Corps, the examiner and the appellant should address the issue of whether the composition claims on appeal should be rejected under the judicially created doctrine of obviousness-type double patenting over the composition claims of the appellant's Patent No. 5,607,667.

In this regard, we observe, for example that appealed composition claim 1 and patent composition claims 1/5 both include an aqueous suspension of charged colloidal silica particles of a size between 10 and 100 angstroms. The guidelines in § 804 of the

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Manual of Patent Examining Procedure (August 2001) should be followed in assessing this issue.

SUMMARY

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS
Administrative Patent Judge

PAUL LIEBERMAN
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

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